

REMARKS/ARGUMENTS

Applicants acknowledge receipt of the Final Office Action dated October 12, 2007, wherein the Examiner bases her rejections on the application of Chatterji, et al. (U.S. 5,688,844) (hereinafter "*Chatterji*") to the claims.

Status of the Claims

Claims 1, 5-6, and 8 are currently amended.

Claim 4 is canceled.

Claims 7 and 17-35 were previously canceled.

Claims 2, 3, and 9-16 are in their original form.

Claims 1-3, 5-6, 8-16 and 36 are currently pending in this application.

Rejections under 35 USC §§ 102(a) & (e)

Claims 1, 2, and 8-16 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Chatterji*. As explained by the Court of Appeals for the Federal Circuit: “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants have amended claim 1 to overcome *Chatterji*’s anticipatory rejection. Claim 1 has been amended to read:

1. A method of servicing a wellbore in contact with a subterranean formation, comprising: displacing a sealant composition comprising a colloidally stabilized latex into the wellbore, wherein the sealant composition does not comprise an epoxy resin or zinc oxide, **wherein the colloidally stabilized latex comprises a polymer, and wherein the polymer comprises an ethylenically unsaturated surfactant, a functionalized silane, or combinations thereof.**

See claim 1 *supra* (emphasis added). Support for the current amendment derives from the subject matter contained in original claims 4 and 6. Additionally, support for amended claim 1 is found in the specification. *See, e.g.* Application at ¶ [0013] ("In one embodiment, the colloidaly stabilized latex also includes a surfactant having ethylenic unsaturation . . . incorporated into the backbone of the polymer."); *see also* Application at ¶ [0015] ("In another embodiment, the colloidaly stabilized latex includes a functionalized silane incorporated in the polymer . . .").

The Office Action relies on *Chatterji*, col.4, lines 40-64, to support the rejection of claim 1.

See Office Action at 2. In the interest of efficiency, *Chatterji*, col.4, lines 40-64 is reporiduced below:

Of the various latexes which can be utilized, those prepared by emulsion polymerization processes are preferred. A particularly preferred latex for use in accordance with this invention is a styrene/butadiene copolymer latex emulsion prepared by emulsion polymerization. The aqueous phase of the emulsion is an aqueous colloidal dispersion of the styrene/butadiene copolymer. The latex dispersion usually includes water in an amount in the range of from about 40% to about 70% by weight of the latex, and in addition to the dispersed styrene/butadiene particles, the latex often includes small quantities of an emulsifier, polymerization catalysts, chain modifying agents and the like. The weight ratio of styrene to butadiene in the latex can range from about 10%:90% to about 90%:10%.

It is understood that styrene/butadiene latexes are often commercially produced as terpolymer latexes which include up to about 3% by weight of a third monomer to assist in stabilizing the latex emulsions. The third monomer, when present, generally is anionic in character and includes a carboxylate, sulfate or sulfonate group. Other groups that may be present on the third monomer include phosphates, phosphonates or phenolics. Non-ionic groups which exhibit stearic effects and which contain long ethoxylate or hydrocarbon tails can also be present.

See *Chatterji* at col. 4, lines 40-64.

Amended claim 1 requires that "the colloidaly stabilized latex comprises a polymer, and wherein the polymer comprises an ethylenically unsaturated surfactant, a functionalized silane, or

combinations thereof.” *See supra* at 2 (Amended claim 1). As evidenced from the *Chatterji* disclosure above, *Chatterji* does not disclose a colloidally stabilized latex comprising “ethylenically unsaturated surfactant, a functionalized silane, or combinations thereof,” because *Chatterji*’s teaches a “third monomer” is utilized to stabilize its emulsions. *See Chatterji* at col. 4, lines 56-58. The “ethylenically unsaturated surfactant” and the “functionalized silane” of amended claim 1 cannot be *Chatterji*’s “third monomer” because neither are monomers. *See Application at ¶¶ [0013], [0015].*

Because *Chatterji*’s disclosure requires a “third monomer” to stabilize its emulsions, and because claim 1 of the instant application has been amended to exclude zinc oxide from the instant application’s sealant composition, *Brothers* cannot be read to anticipate the instant application.

Based on the foregoing, independent claim 1 should be allowed as it is not anticipated by *Chatterji*. Additionally, because dependent claims 2, 4, 8-16, and 36 depend on claim 1, dependant claims 2, 4, 8-16, and 36 should be allowed because they are not anticipated by *Chaterji*.

Rejections under 35 USC § 103(a)

Claims 3 and 5 stand rejected under 35 U.S.C. § 103(a) was being unpatentable over *Chatterji* in view of Krishanan (U.S. 5,900,451) (“*Krishanan*”). Similarly, claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chatterji* in view of Griffith et al. (U.S. 6,448,206) (“*Griffith*”). Thus, claims 3, 5, and 6 stand or fall on the application of *Chatterji* to the claims.

The MPEP provides:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the

analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.

See MPEP § 2143.

In *KSR Int'l Co. v. Teleflex, Inc.*, the United States Supreme Court also noted that, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art,” but, additionally whether “the claim extends to what is obvious.” *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741-42 (2007). Expounding on its edict, the Supreme Court went on to opine that an obviousness determination is based upon a “proper application of *Graham*,” including consideration of “secondary factors” that may weigh against an obviousness determination. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. at 1745 (citing *Graham v. John Deere Co. of Kansas City, et al.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966)). The “proper application of *Graham*” begins with a determination of whether the cited prior art contains all the elements of the contested claims. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. at 22 (an obviousness determination begins with a finding that “the prior art as a whole in one form or another contains all” the elements of the claimed invention.).

The Final Office Action does not establish a *prima facie* case of unpatentability because none of the prior art of record, alone or in combination, teaches each and every element of the pending claims. As explained in reference to the § 102 rejections above, *Chatterji* fails to teach or suggest the limitations contained in claims 3, 5, and 6. The Office Action does not cite *Krishanan*, *Griffith*, or other prior art references, to teach the limitations that are absent from *Chatterji*. Thus, the Office Action does not establish a *prima facie* case of obviousness as to claims 3, 5, and 6 which are allowable over the cited prior art.

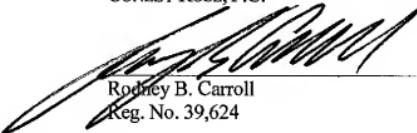
CONCLUSION

Consideration of the foregoing and reconsideration of the application, and withdrawal of the rejections are respectfully requested by the Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Final Office Action dated October 12, 2007 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to contact the undersigned at the telephone number given below.

Respectfully submitted,
CONLEY ROSE, P.C.

Date: 12-14-07


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